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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,262	09/05/2000	L. Pernille Olesen		8025
7590	10/24/2003		EXAMINER	
Poulsen Roger ApS 2550 Old Military Road Central Point, OR 97502			MCCORMICK, SUSAN B	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/655,262	OLESEN ET AL.	
	<b>Examiner</b> Susan B. McCormick	<b>Art Unit</b> 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 September 2003.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

**Detailed Action**

The amendment of August 15, 2003 is hereby acknowledged and entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claim Rejection - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The claim is rejected under 35 U.S.C. 102(b) as being anticipated by the European Plant Breeder's Right (PBR) application number, 19990081, published on April 15, 1999, more than one year filing of this instant application, taken in view of the Canadian PBR application which Applicant has certified that the claimed variety was sold or offered for sale in Denmark on January 29 1999 (page 4 of the Canadian PBR application).

**Response to Arguments**

**Applicant argues** that Foreign Commercial or Public use is Not a Bar to Patentability Under 35 U.S.C. 102(b). This is not relevant. The clear wording of 35 USC § 102(b) is "A person shall be entitled to a patent unless - ... (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States ..." There is no restriction of the bar under 35 USC § 102(b) to printed publications in this country. The second clause of 35 USC § 102(b) barring public sale or use in this country is not relevant because a hypothetical rejection under 35 USC § 102(b) over the foreign breeder right certificate, as enabled by a hypothetical sale to the public in a foreign country over one year prior to the date of domestic filing, would not be over public use or sale, but on a printed publication. Note that in *Gandy v. Main Belting*, there was no printed publication. Whether the combination of a non-enabling printed publication with foreign commercial use is a bar to patentability under 35 USC § 102(b) for utility or plant patents is likewise not at issue. The issue is whether a printed publication, by virtue of

enablement by the knowledge of one of ordinary skill in the art where such a person could have obtained the necessary plant stock publicly, was a bar.

**Applicant argues** that the description in a printed publication must be enabling to the American public to bar patentability under 35 U.S.C. 102(b). This is also irrelevant. Again, the clear wording of 35 USC § 102(b) is “A person shall be entitled to a patent unless - … (b) the invention was patented or described in a printed publication **in this or a foreign country...**” (emphasis added). Applicant has made essentially the same argument repeatedly that the public policy behind all of title 35 and 35 USC § 102(b) in particular is to benefit the American public, and that, coupled with the explicit narrowing of the scope of 35 USC § 102(b)'s clause as to public sale or use to this country, necessarily implies that 35 USC § 102(b)'s first clause as to printed publication must similarly require enablement such that the invention may be practiced in this country. 35 USC § 102(b) contains no such provision, nor is there any case that holds as such. Applicant's contention that *in re LeGrice* supported this because the court disregarded as immaterial evidence that the plant stock had been in public use or sale over one year prior to filing is unpersuasive because the issue was never before the court.

**Applicant argues** *in re LeGrice* and *Imazio* govern the application of 102(b) to plant patents, not *ex parte Thomson*. Although *in re LeGrice* and *Imazio Nursery Inc. v. Dania Greenhouses* were both directed toward plant patents and *ex parte Thompson* was directed toward a utility patent, none of the analysis in any of those three cases distinguished 35 USC § 102(b) application to plant versus utility patents. 35 USC § 102(b) was not at issue in *Imazio Nursery Inc. v. Dania Greenhouses*.

**Applicant argues** the facts of the present case are materially distinguishable from the facts of *ex parte Thomson*. This is false with regard to aspects relevant to analysis of 35 USC § 102(b) issues. The analysis in both cases did not distinguish 35 USC § 102(b) application to plant versus utility patents. In particular, the court in *LeGrice* stated "We therefore hold that descriptions in printed publications of new plant varieties, before they may be used as statutory bars under 35 U.S.C. 102 (b), must meet the same standards which must be met before a description in a printed publication becomes a bar in non-plant patent cases." This statement was repeated in *Thompson*. The same standards apply in utility and plant patents. Because all of the premises behind Applicant's contention that no 35 U.S.C. 102 (b) bar could have pertained are incorrect, the contention is unpersuasive.

Because none of the arguments support Applicant's conclusion that a foreign breeder's right certificate over a year prior to domestic filing cannot be a bar under 35 USC § 102(b), even where Applicant made the plant stock available to the public, albeit outside this country, over a year prior to

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domestic filing, the applicability of a rejection, where both of these conditions arise, under 35 USC § 102(b) is maintained.

Conclusion

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick whose telephone number is (703) 305-1682. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or 308-4242. Additional fax numbers are "before final" (703) 872-9306, "after final" (703) 872-9307 and for customer service is (703) 872-9305.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

sbm



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